

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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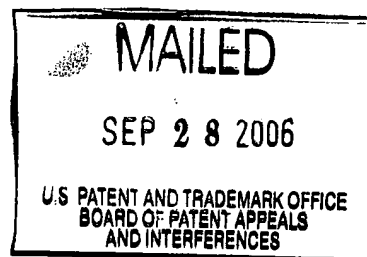
Ex Parte ANDREW M. SPENCER, TODD C. ADELMANN, and MARGO N. WHALE

Appeal No. 2006-2011  
Application No. 09/996,720

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ON BRIEF

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Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6, 8, 9, 12-14, 16-18, 20-27, and 30-33, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and apparatus for storing memory card usage information on a memory card.

Representative claims 1 and 14 are reproduced as follows:

1     A method for storing memory card usage information on a memory card comprising:

collecting information about usage of the memory card using a processor;

recording the information about usage of the memory card in an area of memory of the memory card;

accessing the information about usage of the memory card from the area of memory of the memory card using a processor; and

displaying the information about the usage of the memory card on a display on the memory card.

14. A data structure in a memory card, comprising, computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event, wherein for each of a plurality of event descriptors an amount of memory used by an aggregation of events corresponding to respective each of the event descriptors is provided.

The examiner relies on the following references:

Bueno	5,532,689	July 02, 1996
Bruce et al. (Bruce)	6,000,006	Dec. 07, 1999
Shimizu et al. (Shimizu)	US 2002/0107832	Aug. 08, 2002 (filed Oct. 23, 2001)
Himoto et al. (Himoto)	6,478,679	Nov. 12, 2002 (filed July 21, 1999)
No et al. (No)	6,587,140	July 01, 2003 (filed Oct. 23, 1997)

The following rejections are on appeal before us:

1. Claims 14, 30, and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Bruce.

2. Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Shimizu.

3. Claims 23-26 and 30-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Himoto.

4. Claims 1-6, 8, 9, 12, 13, 16, 17, 23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bruce taken alone.

5. Claims 1-6, 8, 9, 12, 13, 16, 17, and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Shimizu taken alone.

6. Claims 20-22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bruce taken alone.

7. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Shimizu or Bruce in view of Bueno.

8. Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Himoto or Bruce in view of No.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of claim 14. We reach the opposite conclusion with respect to all other claims on appeal. Accordingly, we affirm-in-part.

We consider first the examiner's rejections of the claims under 35 U.S.C. § 102 based on anticipation. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to the rejection of claims 14, 30 and 32 based on Bruce, the examiner has presented findings in support of anticipation [answer, pages 4-6]. With respect to claim 14, appellants argue that the portion of Bruce relied on by the examiner is a physical block address rather than an amount of memory as claimed. Appellants note that while a block address may correspond to a region in memory, it is not itself an amount of memory [brief, pages 6-7]. The examiner responds that it is not the block address that meets the claimed amount of memory, but rather, the block of memory itself is the amount of memory which meets the claimed invention [answer, page 28]. Appellants respond that the write counts in Bruce are not an amount of memory, even if they are stored in memory [reply brief, page 5].

We will sustain the examiner's rejection of claim 14 as being anticipated by Bruce. We agree with the examiner that Bruce discloses a data structure comprising a computer readable storage 50 that contains a count 46 or 48 for at least one event descriptor, total and incremental writes in this case. We do not agree with appellants that the storage of these counts fails to meet

the claimed invention. Claim 14 recites that an amount of memory corresponding to each event descriptor is provided. We agree with the examiner that the storage of write counts in Bruce requires an allocation of an amount of memory to retain this value.

With respect to claims 30 and 32, appellants argue that the portions of Bruce cited by the examiner fail to disclose the number of times data was corrected on a memory card. They note that the fact that Bruce may prevent data from having to be corrected is not a disclosure of accessing information regarding a number of times data is corrected from any memory card [brief, page 7]. The examiner responds that since Bruce teaches preventing data from having to be corrected, then Bruce teaches that the number of times that data is corrected is zero [answer, pages 28-29]. Appellants respond that the number of times data is corrected in Bruce, even if zero, is not stored in a memory on the Bruce device [reply brief, page 5].

We will not sustain the examiner's rejection of claims 30 and 32 based on Bruce for essentially the reasons argued by appellants in the briefs. As noted by appellants, even if the data in Bruce does not have to be corrected, the value of zero (the number of times that data was corrected by the memory card) is not recorded in an area of the memory card as claimed.

With respect to the rejection of claim 14 based on Shimizu, the examiner has presented findings in support of anticipation [answer, pages 6-7]. Appellants argue that Shimizu fails to disclose a computer readable storage containing at least one event descriptor about the usage of the memory card. Appellants argue that the information stored in Shimizu cannot reasonably be interpreted as relating to the usage of a memory card. Appellants argue that the examiner's interpretation of "usage of the memory card" is not consistent with the plain language of the

claims, the specification, or the file history of this case [brief, pages 7-10]. The examiner responds that the information stored on the memory card of Shimizu relates to how that memory card has been and will be used, which constitutes usage of the memory card. The examiner disagrees with the contention that his interpretation is inconsistent with the plain language of the claims, the specification, or the file history [answer, pages 29-31]. Appellants respond that their specification draws a distinction between information about the usage of a memory card and information that is merely stored on a memory card [reply brief, pages 1-2].

We will not sustain the examiner's rejection of claim 14 based on Shimizu. We agree with appellants that the types of information recorded in Shimizu cannot reasonably be interpreted as event descriptors about usage of the memory card as claimed. The memory card in Shimizu records events related to activities of the user, but not about usage of the card. Although the examiner is correct to give the terms recited in the claims their broadest reasonable interpretation, we agree with appellants that the examiner's broadest reasonable interpretation is not reasonable in this case.

With respect to the rejection of claims 23-26 and 30-33 based on Himoto, the examiner has presented findings in support of anticipation [answer, pages 7-10]. With respect to claims 23-26, appellants argue that Himoto does not disclose monitoring usage of the memory card and storing the usage of the memory card in an area on the memory card. Appellants also argue that the information displayed on LCD 14 of Himoto cannot reasonably be interpreted as usage of the memory card [brief, pages 10-11]. The examiner responds that the memory card of Himoto is used to play games and store the scores that result from that play. The examiner asserts,

therefore, that the information stored with respect to each game is usage information of the memory card [answer, page 31-32]. Appellants respond that their specification draws a distinction between information about the usage of a memory card and information that is merely stored on a memory card [reply brief, pages 1-2].

We will not sustain the examiner's rejection of claims 23-26 based on Himoto. We agree with appellants that the types of information recorded in Himoto cannot reasonably be interpreted as event descriptors about usage of the memory card as claimed. The memory card in Himoto records events related to activities of the user, but not about usage of the card. Although the examiner is correct to give the terms recited in the claims their broadest reasonable interpretation, we agree with appellants that the examiner's broadest reasonable interpretation is not reasonable in this case.

With respect to claims 30-33, in addition to the arguments considered above, appellants argue that the portions of Himoto relied on by the examiner merely illustrate the address region in which a program is stored. Appellants assert, however, that Himoto does not disclose a measurement of how full the memory card is [brief, page 11]. In addition to the arguments considered above, the examiner responds that a visual or qualitative measurement is a reasonable interpretation of the fullness of the memory because appellants did not provide any discussion in the specification of how to measure fullness [answer, page 32].

We will not sustain the examiner's rejection of claims 30-33 based on Himoto for reasons discussed above. We also agree with appellants that Himoto has no disclosure related to a measurement of how full the memory card is. The fact that Himoto stores information in certain

regions of the memory does not convey any information about how full the memory is. We agree with appellants that the portions of Himoto relied on by the examiner fail to support the examiner's rejection.

We now consider the examiner's rejections of the claims under 35 U.S.C. § 103 based on obviousness. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the



references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000)). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to the rejection of claims 1-6, 8, 9, 12, 13, 16, 17, 23, and 26 based on Bruce taken alone, the examiner has presented findings in support of obviousness [answer, pages 10-14]. With respect to claims 1, 3-6, 8, 9, 12, 13, 16, 17, and 23, appellants argue that Bruce fails to disclose the step of displaying the information about usage of the memory card on a display on the memory card because Bruce does not suggest that the cards have displays or that any display

on the cards displays information about usage of the cards. In response to the examiner's position that it would have been obvious to the artisan to keep track of memory usage by affixing a sticker to the memory, appellants argue that the claimed display on a memory card cannot reasonably be interpreted as a sticker. Appellants also argue that the examiner's proposed modification of Bruce would render the Bruce device unfit for its intended purpose [brief, pages 11-13]. The examiner responds that the artisan would understand that one can count total writes with slash marks on a sticker as opposed to use of a register memory. The examiner observes that the invention is not limited to an electronic display [answer, pages 33-34]. Appellants respond that the examiner has provided no motivation as to why the artisan would remove the electronic circuitry of Bruce and replace it with stickers and slash marks. Appellants reiterate that the artisan would interpret the claimed invention as a display electrically connected to the other components of the memory card [reply brief, page 3].

We will not sustain the examiner's rejection of claims 1, 3-6, 8, 9, 12, 13, 16, 17, and 23 based on Bruce taken alone. Bruce fails to teach any display on a memory card. The examiner's proposal to modify Bruce to include slash marks on a sticker is not only preposterous since the Bruce memory card is designed to have thousands of writes, but is not suggested anywhere by Bruce. The examiner's proposed modification of Bruce comes only from an improper attempt to reconstruct the claimed invention in hindsight. Since separately argued claims 2 and 26 depend from claims 1 and 23 respectively, we also do not sustain the examiner's rejection of these dependent claims.

With respect to the rejection of claims 1-6, 8, 9, 12, 13, 16, 17, and 20-22 based on Shimizu taken alone, the examiner has presented findings in support of obviousness [answer, pages 14-21]. With respect to claims 1, 3-6, 8, 9, 12, 16, 17, and 22, in addition to the arguments considered above, appellants argue that Shimizu fails to disclose displaying information about the usage of the memory card on a display on the memory card. Appellants also argue that Shimizu does not suggest keeping track of how many times its card has been used, and that replacing its circuitry with a sticker would render the Shimizu device unfit for its intended purpose [brief, pages 14-15]. The examiner responds that the monitor 710 of Shimizu could be considered a display on the memory card [answer, page 36]. Appellants respond that a monitor separate from a memory card is not a display on a memory card as claimed [reply brief, page 5].

We will not sustain the examiner's rejection of claims 1, 3-6, 8, 9, 12, 16, 17, and 22 based on Shimizu taken alone. As noted above in the rejection of claim 14, the information recorded on the memory card in Shimizu cannot reasonably be interpreted as memory card usage. Since separately argued claims 2, 13, 20 and 21 depend from claim 1 or claim 17, we also do not sustain the examiner's rejection of these dependent claims.

With respect to the rejection of claims 20-22, 24, and 25 based on Bruce taken alone, the examiner has presented findings in support of obviousness [answer, pages 21-23]. With respect to claims 20 and 21, in addition to the arguments considered above, appellants argue that even if music files and image files require writes, the examiner has provided no proper motivation as to why the stored image files in Bruce should be music files or image files [brief, page 17]. The examiner responds that appellants failed to challenge findings in support of Official Notice and

that these facts are now admitted prior art. The examiner also notes that since Bruce discloses counting the number of writes, artisans would want to know how close they are to the memory failing so they do not lose songs or pictures that they have saved [answer, page 38]. Appellants respond that despite the taking of Official Notice, the examiner has not provided proper motivation as to why the artisan would have modified the Bruce device to include the claimed features [reply brief, page 4].

We will not sustain the examiner's rejection of these claims based on Bruce taken alone. Since these claims depend from independent claim 17 or claim 23, and since the rejection of these independent claims on Bruce has not been sustained, then the rejection of these dependent claims is also unsupported by the evidence.

With respect to claim 22, in addition to the arguments considered above, appellants argue that the examiner has provided no motivation as to why any formats should be tracked in the Bruce device [brief, page 18]. The examiner responds that since formatting includes writing, it would have been obvious to the artisan to track formatting for the same reasons discussed above with respect to image and audio files [answer, page 38].

We will not sustain the examiner's rejection of claim 22 based on Bruce taken alone. Since claim 22 depends from independent claim 17, and since the rejection of independent claim 17 on Bruce has not been sustained, then the rejection of dependent claim 22 is also unsupported by the evidence.

With respect to claims 24 and 25, appellants argue that the artisan would not modify the Bruce device to include a display for reasons discussed above [brief, page 18]. The examiner responds with arguments that we have considered above [answer, pages 38-39].

We will not sustain the examiner's rejection of these claims based on Bruce taken alone. Since these claims depend from independent claim 23, and since the rejection of independent claim 23 on Bruce has not been sustained, then the rejection of these dependent claims is also unsupported by the evidence.

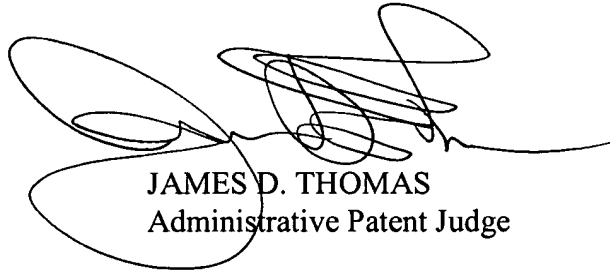
With respect to the rejection of claim 18 based on Shimizu or Bruce in view of Bueno and the rejection of claim 27 based on Shimizu or Bruce in view of No, the examiner has presented findings in support of obviousness [answer, pages 23-25]. Appellants argue that Bueno and No fail to overcome the deficiencies of Shimizu or Bruce [brief, pages 18-19].

We will not sustain the examiner's rejection of either of these claims. Since these claims depend from claim 17 or claim 23, and since the rejection of claims 17 and 23 has not been sustained for reasons discussed above, the rejection of these dependent claims is also unsupported by the evidence in this case for reasons discussed above.

In summary, we have sustained the examiner's anticipation rejection of claim 14 based on Bruce, but we have not sustained any of the examiner's other rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-6, 8, 9, 12-14, 16-18, 20-27, and 30-33 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).


AFFIRMED-IN-PART



JAMES D. THOMAS  
Administrative Patent Judge



ERROL A. KRASS  
Administrative Patent Judge



JERRY SMITH  
Administrative Patent Judge

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